

## **REMARKS/ARGUMENTS**

Reconsideration in view of the following remarks is respectfully requested.

Claim 1 has been amended as required by the office action. Claim 38 was amended to correct a minor editorial matter. No new matter has been added.

Claims 41-52 have been canceled, without prejudice or disclaimer of the subject matter contained therein in this or a subsequent patent application.

### **The 35 U.S.C. § 101 Rejection**

Claims 1-40 stand rejected under 35 U.S.C. § 101 because the claimed inventions are allegedly directed to non-statutory subject matter. This rejection is respectfully traversed. Specifically, the office action states that Claim 1 does not include a sufficient tie to an apparatus. Claim 1 has been amended to recite “using a processing system”. Accordingly, it is respectfully asserted that the claim involves a statutory subject matter. It is respectfully requested that this rejection be withdrawn.

### **The 35 U.S.C. § 102 Rejection**

Claims 41-52 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Nilson et al. (USP 7,113,217). This rejection is respectfully traversed. Claims 41-52 have been cancelled without prejudice or disclaimer of the subject matter contained therein. Accordingly, it is respectfully requested that this rejection be withdrawn.

### **The 35 U.S.C. § 103 Rejection**

Claims 1-40 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nilson et al. (USP 7,113,217) in view of Ntziachristos et al. (USP 6,615,063), further in view of Bruder et al. (USP 7,263,157), among which claim 1 is an independent claim. This rejection is respectfully traversed.

35 USC 103(c) provides that art “which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this

section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Nilson (USP 7,113,217) and the present invention was at the time the invention was made subject to an obligation of assignment to the same person. Assignment of the present invention to Xenogen Corporation is recorded on reel/frame 016566/0251 and assignment of Nilson to Xenogen Corporation is recorded on reel/frame 012159/0249.

As to dependent claims 2-40, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable. It is respectfully requested that this rejection be withdrawn.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

#### Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited and Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant hereby petitions for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-4481 (Order No. XENOP009).

Respectfully submitted,  
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